REMARKS

Reconsideration is requested.

Claims 1-24 are pending. Claims 1-12 have been withdrawn from consideration. Claims 13-24 are under active consideration.

To the extent not obviated by the above amendments, the Section 112, second paragraph, rejection of claims 13, 14, 16, 17 and 19-24 is traversed. Reconsideration and withdrawal of the rejection is requested in view of the following comments.

i) Claim 13 has been amended to delete the phrase "when present" to advance prosecution.

ii) The term "halogen-substituted amino" is an amino group which is substituted with a halogen moiety.

iii) The term "substituted" is not indefinite as those skilled in the art would understand what is claimed when the claim is read in light of the specification.

iv, v, vi) The terms "cycloalkyl," "heteroaryl," and "heterocyclo" are not indefinite with respect to ring size and composition. It is not the function of the claims to describe every possible dimension of a claimed feature. Upon reading the claim in light of the specification, the applicants believe it is evident form the patent specification that one of ordinary skill in the art would easily be able to determine the appropriate dimensions of the objected-to terms.

vi) The applicants submit that, contrary to the Examiner's belief, the term "heterocycloalkyl" is well understood nomenclature.

vii) What is achieved by inhibiting PARP activity in a mammal, why a given mammal needs inhibiting of PARP activity and whether or not a given animal needs the inhibition of PARP are, the applicants believe, clearly described in the Specification (pp. 1-6). Upon reading the claims in light of the specification, one of ordinary skill in the art would readily be able to determine the role of PARP.

Withdrawal of the Section 112, second paragraph, rejection is requested.

The Section 112, first paragraph, rejection of claims 19, 20, 23 and 24 is traversed. Reconsideration and withdrawal of the rejection are requested in view of the following comments.

The applicants respectfully submit that the Examiner's conclusions that "the specification does not provide enablement for treating or inhibiting cancer generally", and that "treatment of neurodegenerative disorders generally is prima facie not enabled" (see, pages 4 and 3 respectively, of the Office Action dated April 25, 2003) are not supported by the art or previous actions of the Patent Office.

Initially, the applicants note that the Courts have appreciated, as stated in *Cortright*, below, that the Patent Office bears the initial burden of establishing a lack of utility (and enablement) and must explain why the claimed invention could not be practiced by one of ordinary shill in the art with a reasonable amount of experimentation.

> As noted in *In re Cortright*, 49 USPQ2d 1464 (Fed. Cir. 1999), the Patent Office bears the initial burden of establishing a lack of utility and must explain why the claimed invention could not be practiced by one of ordinary skill in the art with a reasonable amount of experimentation. Specifically, the court stated the following:

> "The PTO cannot make this type of rejection, however, unless it has reason to doubt the objective truth of the statements contained in the written description. *See Brana*, 51 F.3d at 1566, 34 USPQ2d at 1441 ("The PTO has the initial burden of challenging a presumptively correct assertion of utility in the disclosure. Only after the PTO provides evidence showing that one or ordinary skill in the art would reasonably doubt the asserted utility does the burden shift to the applicant to provide rebuttal evidence sufficient to convince such a person of the invention's asserted utility")(citations omitted); *In re Marzocchi*, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971)("A specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph § 112 unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support"). The PTO may establish a reason to doubt an invention's asserted utility when the written description "suggest[s] an inherently unbelievable undertaking or involve[s] implausible scientific principles." *Brana* 51 F.3d at 1566, 34 USPQ2d at 144; see also *In re Eltgroth*, 419 F2d 918, 164 USPQ 221 (CCPA 1970)(control of aging process)."

Contrary to the Facts presented in *Cortright*, however, the Examiner in the present case has failed to provide any evidence to support the rejection that a method of treating all diseases contemplated by the claims with these compounds is not enabled by the specification.

In fact, the present specification teaches the importance of PARP activity and the inhibition of the same in treating a number of diseases. The compounds of the claimed invention have been demonstrated to have PARP inhibition activity.

The Examiner has failed to meet his burden of establishing a lack of enabling support.

The Examiner has not sufficiently demonstrated that the conclusions of the specification would not lead one of ordinary skill in the art to be able to make and use the claimed invention, with a reasonable amount of experimentation.

The Examiner states, for example, that neurodegenerative disorders "are not treatable using the same drug due to their difference characteristics". The applicants believe however that there are a multitude of drugs that have more than one application. For example, the NMDA-receptor antagonist Namenda™ (memantine HCl) treats moderate to severe Alzheimer's (Recently approved by the FDA, Forest Laboratories, Inc.). The applicants submit that preclinical data shows that the NMDA-antagonist memantine may have further therapeutic potential, e.g. in the treatment of a neuropathic pain, diabetic neuropathy, AIDS-dementia-complex and glaucoma treatment.

Moreover, and perhaps more importantly, the Examiner is requested to appreciate that the Patent Office has previously confirmed that PARP inhibition have broad applicability, as demonstrated by the issuance of at least the following nine patents (copies attached):

PAT. NO.	Title
6,514,983	Compounds, methods and pharmaceutical compositions for treating neural or cardiovascular tissue damage
6,395,749	Carboxamide compounds, methods, and compositions for inhibiting PARP activity
6,387,902	Phenazine compounds, methods and pharmaceutical compositions for inhibiting PARP
6,380,193	Fused tricyclic compounds, methods and compositions for inhibiting PARP activity
6,348,475	Methods, compounds and compositions for treating gout
6,346,536	Poly(ADP-ribose) polymerase inhibitors and method for treating neural or cardiovascular tissue damage using the same
6,306,889	Compounds, methods and pharmaceutical compositions for treating neural or cardiovascular tissue damage

6,201,020	Ortho-diphenol compounds, methods and pharmaceutical compositions for inhibiting parp
6,121,278	Di-n-heterocyclic compounds, methods, and compositions for inhibiting parp activity

(Return of an initialed copy of the attached PTO-1449 Form listing these patents is requested, pursuant to MPEP § 609. The $180 IDS fee is attached.)

Withdrawal of the Section 112, first paragraph, rejection is requested.

Withdrawal of the potential objection to claim 22, should claim 21 be allowed, is requested. See, page 5 of the Office Action dated April 25, 2003. Claim 21 is a composition claim and claim 22 is a method of use claim. These belong to different statutory classes and by definition are not substantial duplicates. 35 USC § 101.

Withdrawal of the Section 102(b) rejection of claim 13 over Ames (Tetrahedron (1984), 40(10), 1919-25) is requested in view of the above amendments. Claim 13 is patentable over Ames.

The Section 102(b) rejection of claims 16 and 17 over Ames is traversed. Reconsideration and withdrawal of the rejection is requested in view the fact that the structure in claims 16 and 17 contain a nitrogen atom that is beta to the middle ring structure. The reference contains a nitrogen atom that is alpha to the middle ring structure, thus the claims are not anticipated, or obvious, in view of the cited art. The Section 102 rejection of claims 16 and 17 over Ames should be withdrawn.

The Examiner's indication that claims 15 and 18 contain allowable subject matter is acknowledged, with appreciation. See, page 6 of the Office Action dated April 25, 2003.

All the claims are submitted to be in condition for allowance and a Notice to that effect is requested.

The Examiner is requested to contact the undersigned in the event anything further is required in this regard.

Respectfully submitted,

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